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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,980	07/14/2005	Bernd Luhmann	101769-283 tesa 1661-WCG	6874
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NORRIS, MCLAUGHLIN & MARCUS, P.A. 875 THIRD AVE 18TH FLOOR NEW YORK, NY 10022				
EXAMINER				
DESAL, ANISH P				
ART UNIT		PAPER NUMBER		
1794				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/516,980

Applicant(s)

LUHMANN ET AL.

Examiner

ANISH DESAI

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed on 07/14/08 after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/14/08 has been entered.
2. The 35 USC Section 103(a) rejections based on Dunshee (US 2002/0165477) in view of Stempel (US 5,492,943) made by the previous Examiner are withdrawn in favor of a new 35 USC Section 102(b) or 103(a) rejection based on Stempel (US 5,492,943).
3. The affidavit/declaration filled under 37 C.F.R 1.132 by Mr. Thorsten Krawinkel is thoroughly reviewed but it is not found persuasive.
4. A new 35 USC Section 103(a) rejection based on Luhmann et al. (US 5,897,949) in view of Ahmed et al. (WO 99/57201) is made.

Claim Rejections - 35 USC § 102 or 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Stempel (US 5,492,943).
6. Regarding claim 1 recitation "A pressure sensitive adhesive for single-sided or double-sided adhesive sheet strip which are redetachable from substrates without residue or destruction by extensive stretching in the plane of the bond", specially the recitation of "for single-sided or double-sided...which are redetachable...in the plane of the bond" is interpreted as an intended use of the "pressure sensitive adhesive". If a prior art discloses a "pressure sensitive adhesive" comprising a mixture of a block copolymer, a tackifier, and a superabsorbent in the amount of 0.5 to 20% by weight based on the weight of the adhesive", then such a PSA will be considered to be functionally capable of meeting the claim requirement of single-sided or double-sided adhesive strip which can be redetachable from substrates without residue or destruction by extensive stretching in the plane of the bond.
7. With respect to claim 1, Stempel teaches a PSA composition comprising a block copolymer, a tackifier, and a suitable water-absorbing and swellable hydrocolloids (superabsorbent) such as sodium carboxymethylcellulose (abstract). Additionally, Examples 1-6 of Stempel teaches a PSA composition that comprising, 18%, 19%, and 20% by weight of superabsorbent (sodium carboxymethyl cellulose), which reads on Applicant's claimed requirement of 0.5 to 20% by weight of superabsorbent based on the weight of the adhesive. With respect to the claim requirement of "for single-sided or double-sided...in the plane of the bond", it is noted that the PSA compositions of

Applicant and Stempel are identical. Specifically, the PSA compositions of Stempel and Applicant comprise a block copolymer, a tackifier, and a superabsorbent in the amount that is claimed by Applicant. Additionally, Stempel teaches "A skin barrier composition [PSA composition] should have sufficiently high cohesive strength to resist disintegration throughout its duration of use and to remain intact at the time of removal so that little or no residue remains adhered to the skin." (column 1 lines 25-35). Further, the PSA composition of Stempel is applied to a thermoplastic backing (see column 5 lines 5-16). Therefore, it is reasonable to presume that aforementioned claimed requirement would be present in the PSA composition of Stempel. The burden is respectfully shifted to Applicant to prove it otherwise (see *In re Fitzgerald*, 205 USPQ 594). In addition, the aforementioned claimed requirements would obviously have been present once the PSA composition of Stempel is provided (see *In re Best*, 195 USPQ at 433, footnote 4 CCPA 1977). Accordingly, Stempel anticipates or strongly suggests the claimed invention.

8. Claims 1 and 4-9 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ahmed et al. (WO 99/57201).
9. Regarding claim 1, this claim is interpreted as set forth previously in Section 6 above.
10. Ahmed teaches an adhesive composition (page 8 lines 7-22) that comprises a thermoplastic polymer such as a block copolymer (page 9 lines 18-30), a tackifier (page 9 lines 30-31), superabsorbent (referred to as SAP by Ahmed) (abstract and page 8

lines 20-21), and additives (page 14 lines 30-31 to page 15 lines 1-5). Further, the superabsorbent containing thermoplastic composition (adhesive) of Ahmed can be applied to tape backings (page 21 lines 20-30). Additionally, at page 16 lines 25-26, Ahmed discloses that the superabsorbent polymer of his/her invention is present in the amount of from 5% by weight to about 70% by weight. Further, Ahmed teaches that "The thermoplastic composition [adhesive] of the present invention can comprise **at least one** SAP polymer admixed with the thermoplastic component." (page 16 lines 20-25). Further, as superabsorbents polymers, Ahmed discloses "These polymers includes...**starch-acrylic acid graft copolymers** [equated to Applicant's starch modified polyacrylic acid]...**slightly network crosslinked polymers of any of the foregoing copolymers...crosslinked polymers of partially neutralized polyacrylic acid.**" (page 18 lines 10-30).

11. With respect to the claim requirement of "a pressure sensitive adhesive for single-sided or double-sided...in the plane of the bond", it is noted that the PSA compositions of Applicant and Ahmed are identical. Specifically, PSA compositions of Stempel and Applicant comprise a block copolymer, a tackifier, and a superabsorbent in the amount that is claimed by Applicant. Therefore, it is reasonable to presume that aforementioned claimed requirement would be present in the adhesive composition of Ahmed. The burden is respectfully shifted to Applicant to prove it otherwise (see *In re Fitzgerald*, 205 USPQ 594). In addition, the presently claimed properties would obviously have been present once the adhesive composition of Ahmed is provided (see

In re Best, 195 USPQ at 433, footnote 4 CCPA 1977). Accordingly, Ahmed anticipates or strongly suggests the presently claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1 and 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luhmann et al. (US 5,897,949) in view of Ahmed et al. (WO 99/57201).
13. Regarding claim 1, Luhmann teaches a pressure sensitive adhesive tape that can be detached without residue and without destruction by stretching in the bond plane (column 2 lines 25-30), wherein the PSA of Luhmann comprises a block copolymer (column 3 lines 60-65) and a tackifier (column 4 lines 15-25). The PSA tapes of Luhmann have applications in the fields of insulating elements, sealing elements etc. (column 3 lines 45-60).
14. With respect to claims 1 and 4, the difference between the claimed invention and the prior art of Luhmann is that Luhmann is silent as to teaching PSA comprising a superabsorbent as presently claimed. The invention of Ahmed is previously disclosed and it is incorporated here by reference. Additionally, it is noted that according to Ahmed, water-insoluble, water swellable superabsorbents are capable of absorbing large quantities of liquid such as water and capable of retaining such absorbed liquids

under moderate pressure (page 1, Background of the Invention, lines 19-25).

Additionally, Ahmed at page 1 lines 25-26 discloses that superabsorbent is used in the various cable applications to shield the penetration of moisture.

15. It is noted that the PSA of the primary reference of Luhmann includes a block copolymer and a tackifier. Further, the PSA tape of Luhmann is used in insulating and sealing applications (column 3 lines 55-60), where penetration of moisture and liquid (e.g. water) would be undesirable. The secondary reference of Ahmed provides adhesive composition containing superabsorbents that can absorb large quantities of liquid and further provide shielding against moisture penetration. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add the superabsorbent polymer of Ahmed in the amount as taught by Ahmed in the PSA of Luhmann, motivated by the desire to form PSA tape that can effectively provide shielding against moisture and liquid penetration.

16. Regarding claims 5, 6, and 9, as previously noted Ahmed teaches that "The thermoplastic composition [adhesive] of the present invention can comprise **at least one** SAP polymer admixed with the thermoplastic component." (page 16 lines 20-25).

Further, as superabsorbents polymers, Ahmed discloses "These polymers includes...**starch-acrylic acid graft copolymers** [a starch modified polyacrylic acid]...**slightly network crosslinked polymers of any of the foregoing copolymers...crosslinked polymers of partially neutralized polyacrylic acid.**"

(page 18 lines 10-30). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add the superabsorbent polymer of Ahmed

in the amount as taught by Ahmed in the PSA of Luhmann, motivated by the desire to form PSA tape that can effectively provide shielding against moisture and liquid penetration. Regarding claim 7, Luhmann discloses that the PSA of his/her invention includes fillers (equated to additive) (column 4 lines 30-40).

Response to Arguments

17. Applicant's arguments filed on 07/14/08 have been fully considered but they are not persuasive.

18. With respect to the reference of Stempel (US 5,492,943), Applicant argues that Stempel's adhesive **must** have water-absorbers in the amount of from 35 to 65% (column 4 lines 43-44) whereas Applicant's claims are now limited to 0.5 to 20% by weight of superabsorbents. The Examiner respectfully disagrees. It is respectfully submitted that while column 4 lines 43-44 of Stempel does not teach the amount of superabsorbents within the claimed range, Examples 1-6 of Stempel disclose the amount of superabsorbent within the claimed range, i.e., the adhesive composition including 19 wt% (see Examples 1, 2, and 5), 18 wt% (see Example 3), and 20 wt% (see Example 4) of superabsorbent. Thus, the weight% of superabsorbent as taught by Stempel is within Applicant's claimed amount of superabsorbents (i.e. between 0.5 to 20%).

19. The declaration submitted under 37 C.F.R 1.132 by Mr. Thorsten Krawinkel and the arguments based on the declaration are not found persuasive for the following reasons:

20. It is noted that the Mr. Krawinkel has stated that "It is understood by those skilled in the adhesive art that the adhesive which is intended to be removable from a substrate to which it has become adhesively bonded, without leaving a residue behind or being destroyed, by extensive stretching in the plane of the bond, should have a tensile strength of more than 3N/mm^2 ." According to Mr. Krawinkel, the examples of the presently claimed invention (e.g. Example 5) shows that the adhesive has a tensile strength of at least 9.7 MPa , which converts to 9.7 N/mm^2 , whereas the adhesive of Stempel reference has a tensile strength of 16.6 psi (Sample 2 in Example 14), which converts to 0.114 N/mm^2 . The Examiner respectfully disagrees. In response, it is respectfully submitted that the statement made by Mr. Krawinkel ("it is understood by those skilled in the adhesive art...tensile strength of more than 3N/mm^2 ") is not found persuasive because it is based on Applicant's personal opinion and without any factual evidence on the record. Additionally, Applicant's claimed invention does not require any tensile strength. Further, it is respectfully submitted that the comparison between Example 5 of Applicant's invention and Sample 2 in Example 14 of Stempel invention is misplaced because adhesive compositions of Example 5 of Applicant and Sample 2 Example 14 of Stempel are not necessarily same. For example, Applicant's Example 5 uses superabsorbent such as crosslinked polyacrylic acid whereas Sample 2 of Stempel uses sodium carboxymethyl cellulose as a superabsorbent. Accordingly, the declaration and Applicant's arguments are not found persuasive.

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. CA 2274649A1 (related to Applicant's DE 19652762A1 cited on page 6 of the specification) discloses a hotmelt adhesive comprising a block copolymer, tackifier and a superabsorbent (abstract). Additionally, pertinent prior art is EP1013291A1 which discloses a hot melt adhesive comprising superabsorbent polymers (abstract).

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANISH DESAI whose telephone number is (571)272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

23. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Tarazano can be reached on 571-272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. D./

Examiner, Art Unit 1794

/Hai Vo/

Primary Examiner, Art Unit 1794